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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1962.

No. 138.

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE, Deceased,
Petitioner,

vs.

ALLEN B. DUMONT LABORATORIES, INC.,
Respondent.

PETITIONER'S REPLY TO RESPONDENT'S SUPPLEMENTAL BRIEF

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Petitioner shall treat with the two matters raised in Respondent's Supplemental Brief in Opposition to Petition, in inverse order.

The Conflict of Circuits As to the Validity of the Pierce Patent Is a Conflict on a Vital Point of Patent Law, and Not a Conflict of Fact

The incorrectness of respondent's attempt to twist the conflict of circuits into a mere conflict of "fact", as to whether or not the Patent Office ordered a division of

patent applications leading to the granting of two patents to Professor Pierce, is evident from the statement of the Court of Appeals for the Third Circuit *itself*, that, even on its fact finding, this is a

> "case involving difficult and doubtful points of *law*" (*not* fact), as to so-called illegal extension of monopoly.

The First Circuit, indeed (like the Fifth Circuit), found that the earlier Pierce patent

> "issued on an application filed . . . as a division *by Patent Office order.*" (*Pierce* v. *American Communications Company, Inc., et al.*, 280 F.2d 278, 280, 1 Cir., 1960).

Similarly, the courts of the Third Circuit found that the Patent Office had forced Professor Pierce to divide, holding only that there was no "formal" order for division, but that Professor Pierce saw

> "that he would either have to divide or suffer a final rejection by the Examiner". (*Pierce* v. *Allen B. DuMont Laboratories, Inc.*, 297 F.2d 323, 328, 3 Cir., 1961, Appendix to Petition herein, p. 22).

There is thus no "fact" conflict of any consequence, as is also made plain in the latest decision, a few weeks ago, of the Court of Appeals for the Fifth Circuit:

> "It is clear beyond dispute, however, that it was the Patent Office that made plain to Pierce that a patent would not issue covering all the claims which, if divided, might be the subject of separate patents." (*Pierce* v. *Aeronautical Communications Equipment, Inc.*, September 6, 1962, Appendix to Petitioner's Supplemental Brief, p. 3A.)

The conflict of circuits as to the validity of the Pierce patent is thus clearly a *conflict of law*.

The Respondent Is in Error in Stating That the Supreme Court Has Refused Certiorari, Even After Patent Expiration, Where Two Circuits Have Disagreed on Valjdity

In petitioner's supplemental brief, she states that to her knowledge,

> "the Supreme Court has *always* considered the granting of certiorari to be essential in cases where a patent has specifically been held valid in one circuit and invalid in another, since this raises an intolerable conflict of law."

Respondent apparently agrees except for an alleged single instance, *Frank B. Killian & Co.* v. *Allied Latex Corp.*, 188 F.2d 940, 2 Cir., 1951, cert. den 342 U.S. 861, 895.

But respondent is entirely *incorrect* as to that single instance. In that case, to the contrary, Patent 1,605,445, held valid in *Dean Rubber Mfg. Co. et al.* v. *Killian*, 106 F.2d 316, 8 Cir., 1939, was also earlier held valid in the second circuit, *Stevens* v. *Carl Schmid, Inc.*, 73 F.2d 54, 2 Cir., 1934, and was merely held *not infringed* (but not *invalid*) in *Frank B. Killian & Co.* v. *Allied Latex Corp.*, 188 F.2d 940, 2 Cir., 1951:

> "decide this action upon the issue of non-infringement *without actually overruling any of the past decisions*" (p. 942).

It is because there was *no* conflict on *validity* that the Supreme Court doubtless denied certiorari.

The petitioner's statement that contrary holdings of validity have *always* been resolved by the Supreme Court thus stands.

Because of the long-term consequences of a six-year statute of limitations on infringement

> "A direct conflict of decisions between Courts of Appeals . . . as to *validity* . . . is a sufficient ground in itself for the granting of a petition for a writ of certiorari. . . . The moving consideration for the granting of the writ in these cases is the practical fact that a particular patent or claim thereof is valid in one circuit and invalid in another"[1];

certiorari having apparently always been granted under Rule 19(b) of this Court,[2] in the circumstances of the present case, *even after the patent in suit has expired.*[3]

The more so is certiorari in order in the present case in view of

(1) the conflict of the Third and Fifth Circuits as to the effect of this Court's recent holding on the scope of combination and element patents in *Aro Mfg. Co.* v. *Convertible Top Replacement Co.*, 1961, 365 U.S. 336, that a combination claim does *not* protect only an element (with which the Fifth Circuit agrees, but with which the Third Circuit, by the consequences of its decision, disagrees);

(2) the now unsettled status of well over a half a million patents for new combinations of elements, as well as for new elements by themselves, already granted, *as in Professor Pierce's case*, without regard to order of issuance; and

(3) the present practice of the Patent Office that, *if the Third Circuit decision is permitted to stand*, is currently spawning invalid patents every week in the *precise manner of Professor Pierce's case.*

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1. Wolfson and Kurland, "Jurisdiction of the Supreme Court of the United States", 1951, Section 354, p. 705.

2. "Where a Court of Appeals has rendered a decision in conflict with the decision of another court of appeals on the *same* matter . . . ."

3. Wolfson and Kurland, *supra*, pp. 706, 707.

CONCLUSION

Settling of what the Third Circuit Court of Appeals itself admitted were such "difficult and doubtful points" of patent law, thus thrown into confusion by this conflict of decisions is believed to be as worthy of attention as at least some of the personal liberty causes so freely championed by this Court.

The *same Constitution* that protects the individual's personal liberties, guarantees the inventor, also, the protection of his discoveries (Article I, Section 8).

Respectfully submitted,

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